



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY	DOCKET NO.
08/567,564	12/05/95	KULLAR	J	14

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12M2/1219

NAZARIO EXAMINER, P

12ART UNIT	PAPER NUMBER
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DATE MAILED: 12/19/97

#9

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/567,564

Applicant(s)

J. Kollar

Examiner

Porfirio Nazario-Gonzalez

Group Art Unit

1204



☒ Responsive to communication(s) filed on Sep 22, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-17 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-17 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed September 22, 1997, Paper No. 8, have been fully considered but they are not persuasive. Applicant argues that: (i) upon the filing of a Protest under 35 U.S.C. § 1.291(a) by Arco Chemical Technology on January 30, 1997, Paper No. 5, *ex parte* proceedings are no longer present in the case but rather an *inter-party* matter that is under the jurisdiction of the Board of Patent Appeals and Interferences, and (ii) "It is not a mere utterance of an offer for sale that constitutes an anticipation. It is the public disclosure and an offer to sale that specifically disclosed invention which could constitute an anticipation". Further, Applicant argues that Exhibit 6 (from Paper No. 3) is only a "proposed confidentiality agreement" which provided for the disclosure of confidential [emphasis added] information from Redox Technologies to Arco Chemical Company ("ACC") for the purpose of evaluating the "Technology". Furthermore, Applicant cited Moleculon Research Corp. v. CBS, 229 USPQ 805 (Fed. Cir. 1986) in support of his arguments.

2. The Examiner fully disagrees with Applicant's arguments. First, according to 37 CFR § 1.607(b) it is the Examiner's responsibility to determine whether there is interfering subject matter in the application based on a preponderance of the evidence presented and "if the examiner determines that there is no interfering subject matter, the examiner shall state the reasons why an interference is not being declared". The Examiner followed the regulation by issuing an Office

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Action, Paper No. 6, in which the Examiner stated the reasons for not declaring an interference that the Applicant requested. The reason, as stated previously (see Paper No. 6), is that Exhibit 6 clearly shows that Applicant intended to sell the "Technology" to ACC within the meaning of 35 U.S.C. § 102(b). Although a Protest was filed under 35 U.S.C. § 1.291(a) by Arco Chemical Technology, it does not change the basic fact of the *prima facie* case for use or sale within the meaning of 35 U.S.C. § 102(b) based on Exhibit 6. Applicant have the option of appealing the Examiner's rejection to the Board of Patent Appeals and Interferences in accordance with 37 CFR § 1.191(a).

3. Applicant argues that public disclosure and an offer to sell are requirements for anticipation. It is Applicant's contention that the "secrecy agreement" protects the instant invention from public disclosure. Further, Applicant maintains that Exhibit 6 is not an offer to sell or a sale. The Examiner disagrees. First, it is the "offer to sell" (Exhibit 6) plus the reduction to practice of the instant invention before the "critical date" which constitutes anticipation ("on sale") as required by the statute. See *Hobbs v. United States, Atomic Energy Commission*, 171 USPQ 713 (CA 5 1971). Second, the statement on page 2, lines 13-16, which states:

ACC desires to receive a disclosure of the Technology from REDOX for the purpose of evaluating the Technology to determine whether ACC desires to make an offer to REDOX to acquire the Technology.

shows that in order for ACC to "make an offer to REDOX" Applicant must have made an "offer to sell" the Technology. Third, the evaluation of the Technology by ACC for the sum of \$20,000 is not for experimental purposes but rather to ascertain the commercial value. Furthermore,

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Applicant in Exhibit A stated that "comprehensive and complete details concerning the invention of the Proposed count" were communicated to inventors of the U.S. Pat. 5,371,298 as well as other employees of Arco Chemical Technology, L.P. which is an acknowledgement that such evaluation took place more than a year prior to the "critical date". In addition, Applicant have not rebutted, or presented evidence to the contrary, the Examiner's argument that the "evaluation" of the "technology" by ARCO was not experimental but rather for commercial exploitation. See prior Office Action, Paper No. 6, page 3, lines 1-6. Thus, the Examiner have presented a *prima facie* case in the rejection of claims 1-17 under 35 U.S.C. § 102(b) for public use or sale.

4. The Examiner wants to clarify for the record the statement on page 3 of the prior Office Action, Paper No. 6, in which the Examiner requested pages 2-22 of Exhibit 3. A determination as to whether Exhibit 3 showed also a *prima facie* case for public use or sale under 35 U.S.C. § 102(b) could not be made based on the incomplete documentation of Exhibit 3. The above statement does not change the rejection of claims 1-17 under 35 U.S.C. § 102(b) for public use or sale based on Exhibit 6.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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6. Claims 1-17 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. The agreement between Celanese Corporation and Redox (see Exhibit 3 and pages 2-22 included with Applicant's response filed September 22, 1997) shows that the instant claimed process was disclosed as part of the "Field" in which research and development (R&D) was conducted for unspecified fees (note that the amounts paid by Celanese to Redox has being black out) for a period of 5 years, see section 2.3 of the agreement. Second, the R&D conducted by Celanese in the "Field" was not under the supervision of the inventor, see section 2.5 of the Agreement. Further, section 5, set forth a Commercial Phase in which any product resulting from the Field was made and sold by Celanese must pay a royalty to Redox. Again, the Agreement (Exhibit 3) suggest that the R&D activity was not "substantially for the purposes of experiment". *Baker Oil Tools, Inc. V. Geo Vann, Inc.*, 828 F.2d 1558, 1564, 4 USPQ2d 1210. It is clear from the Agreement that "commercial exploitation" was the primary purpose rather than experimentation. Therefore, commercial exploitation of the claimed instant process prior to the critical date, even though the process was keep secret, constitutes a *prima facie* case for public use or sale under 35 U.S.C. § 102(b). Thus, claims are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention for the above mention reasons.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Nazario-Gonzalez whose telephone number is (703) 308-4632. The examiner can normally be reached on Tuesday-Friday from 8:30 AM to 6:00 PM. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Geist, can be reached on (703) 308-1701. The fax phone number for this Group is (703) 308-4556.

Serial Number: 08/567,564

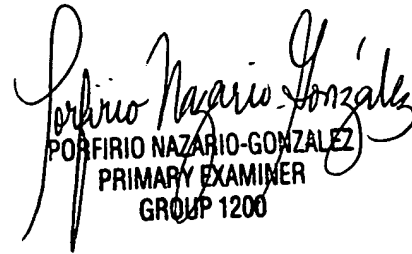
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

PNG

December 16, 1997


PORFIRIO NAZARIO-GONZALEZ
PRIMARY EXAMINER
GROUP 1200